

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT M. McNAMARA

Appeal No. 96-2266
Application 08/156,794¹

ON BRIEF

Before CALVERT, MEISTER and ABRAMS, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 15, 26 and 36 to 38. Of the other claims in the application, the examiner has allowed claims 27 to 35, and indicated that

¹ Application for patent filed November 23, 1993. According to appellant, this application is a continuation of Application 07/810,675, filed December 19, 1991, now abandoned.

Appeal No. 96-2266
Application 08/156,794

claims 16 to 24 would be allowable if rewritten in independent form.

Claim 1 is representative of the subject matter in issue:

1. An apparatus for the introduction or removal of liquid based material to or from a blood vessel of a patient by a clinician comprising:

means for connecting into the blood vessel to continuously introduce liquid based material into or remove liquid based material from the blood vessel, said connecting means fluidically sealed and self-sealing such that the liquid based material is prevented from escaping from the apparatus and coming into contact with the clinician at all times during installation and operation of the apparatus; and

means for controlling whether liquid based material is continuously introduced into or removed from the blood vessel while the connecting means is in contact with the blood vessel without escape of the liquid based material therefrom, said controlling means in fluidic connection with said connecting means.

The references relied upon by the examiner in the final rejection are:

Thomas et al. (Thomas)	3,859,998	Jan. 14, 1975
Frankhouser et al. (Frankhouser)	4,417,886	Nov. 29, 1983
Christian	5,141,498	Aug. 25, 1992
		(filed Sep. 10, 1991)

The claims on appeal stand finally rejected as follows:

(1) Claims 1, 2 and 26, anticipated by Christian, under
35 U.S.C. § 102(e);

(2) Claims 3 to 14 and 36 to 38, unpatentable over Christian in view of Thomas, under 35 U.S.C. § 103;

(3) Claim 15, unpatentable over Christian in view of Thomas and Frankhouser, under 35 U.S.C. § 103.

Rejection (1)

Christian discloses a device 12 having tubular part 42 having a side inlet 61 controlled by a stop cock 56. At one end of part 42 is a flexible valve 11 through which "various types of devices or tools," such as trocar 66, may be introduced. At column 4, lines 14 to 48, the patentee discloses that the device may be used in connection with endoscopic surgery, the device being used with trocar 66 to penetrate the abdominal wall, and the valve 11 then retaining the gas in the abdominal cavity even after the trocar is withdrawn and additional tools are inserted through the valve. Christian also discloses in column 5, lines 21 to 37, that plural surgical tools can be nested together so that one can be inserted through another to go through a common opening to perform a multiplicity of procedures, valve 11 at all times retaining gas within the cavity.

In order to anticipate a claim, a reference must disclose, expressly or under principles of inherency, each and every element of the claimed invention. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984). An element expressed in terms of means plus function is not anticipated unless the reference discloses structure capable of performing the functional limitation of the means. Id.

In the present case, claim 1 requires a "means for connecting into the blood vessel to continuously introduce liquid based material into or remove liquid based material from the blood vessel." The examiner does not explain, and it is not apparent to us, where Christian discloses structure capable of performing this function. The trocar shown by Christian in Figure 8 is a solid instrument, and as noted above, it is disclosed for use in penetrating the abdominal wall, after which it is withdrawn from tube 42 and instruments are inserted through the tube into the abdominal cavity. There is no disclosure of introducing anything into or removing anything from a blood vessel, nor is it evident that what is disclosed would be capable of performing such a

function. Contrary to the examiner's statement on page 2 of the final rejection (Paper No. 12), in determining whether claim 1 is anticipated by Christian one cannot look at the structure disclosed by Christian absent the intended use, since the claimed structure is defined by the means plus its function (intended use).

We therefore conclude that claim 1 is not anticipated by Christian. Claim 2, dependent on claim 1, and claim 26 are likewise not anticipated. Rejection (1) will not be sustained.

Rejection (2)

The secondary reference applied in this rejection, Thomas, discloses a needle 11 having a catheter 15 thereover and connected to a blood detecting chamber 14. After the needle and catheter have been inserted into a blood vessel, the needle may be withdrawn and an appropriate administration set or other device attached to the free end (hub 16) of the catheter. The examiner takes the position that it would have been obvious to utilize the Thomas needle-catheter assembly by insertion through the valve 11 of the apparatus of Christian (final rejection, page 2; answer, page 4).

Appeal No. 96-2266
Application 08/156,794

Appellant argues that the combination of Christian and Thomas is improper since neither recognizes the problem overcome by appellant's invention (brief, page 22). However, this is not conclusive with regard to the question of obviousness, because:

As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. [Citations omitted.]

In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

Nevertheless, we will not sustain the rejection. In the first place, we find no suggestion in Christian or Thomas that one of ordinary skill performing endoscopic surgery would ever have occasion to insert an intravenous needle assembly, such as disclosed by Thomas, through a device such as disclosed by Christian into the abdominal cavity. There being no teaching in the references to this effect, it is mere speculation to presume that it would have been obvious to do so.

Secondly, even if the Thomas needle assembly were inserted through valve 11 of the Christian device, the resulting combination would not meet all the limitations of

the claims. As appellant points out at page 21 of his brief, when the plug 20 (and needle 11) are removed from catheter hub 16, "blood can leak from the device until the proper equipment is connected." The combination of Christian and Thomas would not, therefore, meet the limitation of parent claim 1 that the connecting means is "fluidically sealed and self-sealing . . . at all times during installation and operation of the apparatus," nor of claim 36 that "liquid based material is prevented from escaping from the apparatus . . . during installation and operation of the apparatus."

We note that claim 36 also recites "a self-sealing diaphragm fixedly attached to the second end [of the hollow central portion to which the catheter is sealingly fixed]," and "N side ports extending from said central portion." These limitations would clearly not be met if the examiner's proposed combination is to position the Thomas needle and catheter through Christian's valve 11, because the recited "hollow central portion" would be Thomas' hub 16, which has no diaphragm valve or side ports. If the examiner intended to state that it would have been obvious to insert Thomas' needle through valve 11 of Christian, utilizing Christian's tube 42

Appeal No. 96-2266
Application 08/156,794

in place of the Thomas catheter 15, we do not consider such a combination to be suggested by these two references, there being no disclosure of use of the Christian tube 42 as a catheter into a blood vessel.

Rejection (3)

This rejection will also not be sustained, since Frankhouser, the additional reference applied, does not supply the above-noted deficiencies of Christian and Thomas.

Conclusion

The examiner's decision to reject claims 1 to 15, 26 and 36 to 38 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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JAMES M. MEISTER)	BOARD OF PATENT
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Appeal No. 96-2266
Application 08/156,794

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